

REMARKS:

Claims 1-42 are currently pending in the application. Claims 1-4, 6, 8, 10-15, 19-23, 27-28, 31-33, and 36-40 stand rejected under 35 U.S.C. § 103(a) over OraEDI, Oracle e-Commerce Gateway, User's Guide, Release 11i.2, August 2000 ("OraEDI") in view of U.S. Patent No. 6,091,835 to Smithies, et al. ("Smithies"). Claims 5, 7, 9, 16-18, 24-26, 29-30, 34-35, and 41-42 stand rejected under 35 U.S.C. § 103(a) over OraEDI in view of Smithies and in further view of U.S. Publication No. 2003/0050958 to Keller, et al. ("Keller").

By this Amendment, claims 1, 12, and 30 have been canceled without prejudice and claims 2-6, 8-11, 13-17, 19-25, 27-29 and 31-42 have been amended to more particularly point out and distinctly claim the Applicant's invention. In addition, claims 7, 18, and 26 have been amended to correct certain typographical errors. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-4, 6, 8, 10-15, 19-23, 27-28, 31-33, and 36-40 stand rejected under 35 U.S.C. § 103(a) over OraEDI in view of Smithies. Claims 5, 7, 9, 16-18, 24-26, 29-30, 34-35, and 41-42 stand rejected under 35 U.S.C. § 103(a) over OraEDI in view of Smithies and in further view of Keller.

Although Applicant believes claims 1-42 are directed to patentable subject matter without amendment, the Applicant has canceled claims 1, 12, and 20 and amended claims 2-6, 8-11, 13-17, 19-25, 27-29 and 31-42 to more particularly point out and distinctly claim the Applicant's invention. In addition, the Applicant has amended claims 7, 18, and 26 to correct certain typographical errors. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicant respectfully submits that OraEDI, Smithies, or Keller either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 1-42. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of claims 1-42 under 35 U.S.C. § 103(a) over the proposed combination of OraEDI, Smithies, and Keller either individually or in combination.

For example, with respect to amended independent claim 30, this claim recites:

An electronic commerce system for third party document reuse of transaction documents, the system comprising:

one or more document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document and at least portions of each transaction document capable of being used to facilitate a transaction with one or more of the parties to the transaction document;

a global content directory including a plurality of classes organized in a hierarchy, each class categorizing the transaction documents and associated with one or more attributes of the transaction documents categorized in the class, at least one of the classes having one or more associated pointers that identify one or more document repositories;

an intelligence module operable to, in response to selection of a transaction document by a party who was not a party to the past transaction associated with the transaction document, create a generic document capable of being used to facilitate a future transaction with at least one of the parties from the selected transaction document stored in the one or more document repositories, encrypt at least a portion of the selected information in the selected transaction document thereby making it inaccessible in the generic document; and

a search interface operable to communicate a search query for transaction documents to one or more document repositories identified by one or more pointers associated with one or more selected classes.
(Emphasis Added).

Amended independent claims 28, 35, and 42 recite similar limitations. OraEDI, Smithies, or Keller either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 2-11, 13-19, and 21-42.

For example, the Examiner asserts that OraEDI discloses an electronic commerce system for the reuse of transactional documents. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in OraEDI.

The Applicant respectfully submits that OraEDI does not disclose an electronic commerce system for third party document reuse of transaction documents as recited in amended independent claims 28, 30, 35, and 42. Although OraEDI discloses an e-commerce gateway for conducting business electronically between trading partners based on Electronic Data Interchange. (Page 1-2). OraEDI does not disclose, teach, or suggest an electronic commerce system for third party document reuse of transaction documents including a document repository for storing transaction documents associated with a past transaction of a party to the transaction document where a portion of the transaction document is capable of being used to facilitate a transaction with one or more of the parties to the transaction document. The Applicant further submits that OraEDI does not disclose, teach, or suggest that the e-commerce gateway of OraEDI is in anyway associated with a document repository or a third party associated with the transaction document or any other party associated with the transaction other than the trading partners. Thus, OraEDI cannot provide a document repository for storing transaction documents associated with a past transaction of a party to the transaction document since OraEDI does not even provide a transaction document or any other type of electronic data exchange to a third party to the transaction document for storing in a document repository.

The Applicant further submits that the Office Action acknowledges, and the Applicant agrees, that OraEDI fails to disclose the emphasized limitations noted above in amended independent claim 30. Specifically the Examiner acknowledges that OraEDI fails to teach the documents are each associated with a past transaction. (12 May 2005 Office Action, Page 3). However, the Examiner asserts that the cited portions of Smithies disclose the acknowledged shortcomings in OraEDI. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in Smithies.

The Applicant still further submits that Smithies has nothing to do with amended independent claim 30 limitations regarding: (1) an electronic commerce system for third party document reuse of transaction documents; (2) one or more document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document and capable of being used to facilitate a transaction with one or more of the parties to the transaction document; (3) a global content

directory including a plurality of classes having one or more associated pointers that identify one or more document repositories; and (4) an intelligence module operable to encrypt at least a portion of the selected information in the selected transaction document thereby making it inaccessible in the generic document. Rather Smithies discloses a system for providing a transcript of a single party during a voluntary statement memorializing circumstances which may help the party remember the circumstances in the future. (Abstract and Column 13, Lines 32-41).

Smithies merely discloses this system for providing a transcript to help a single party remember circumstances in the future and does not teach, suggest, or even hint at: (1) an electronic commerce system for third party document reuse of transaction documents; (2) one or more document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document and capable of being used to facilitate a transaction with one or more of the parties to the transaction document; (3) a global content directory including a plurality of classes having one or more associated pointers that identify one or more document repositories; and (4) an intelligence module operable to encrypt at least a portion of the selected information in the selected transaction document thereby making it inaccessible in the generic document. Thus, Smithies cannot provide an electronic commerce system for third party document reuse of transaction documents, since Smithies does not even provide past transactional document, a past transcript or even any other type of past document stored in a document repository that provides for selected information to be made inaccessible in a created generic document by encryption.

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of OraEDI or Smithies, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine

Smithies' teaching with OraEDI's because both references are devoted to e-commerce and transaction document processing. (12 May 2005 Office Action, Pages 3-4).

The Applicant further submits that these purported advantages relied on by the Examiner to make such a combination of further enhancing OraEDI system's functionality are nowhere disclosed, taught, or suggested in OraEDI or Smithies either individually or in combination. The Applicant respectfully requests the Examiner to point to the portions of OraEDI or Smithies which contain the teaching, suggestion, or motivation to combine these references for the purpose of obtaining a web-customizable automatic interface. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. Id. at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of OraEDI or Smithies either individually or in combination.

The Applicant respectfully submits that the Office Action further acknowledges, and the Applicant agrees, that OraEDI and Smithies fail to disclose the emphasized limitations in now amended independent claims 30, 35, and 42 and dependent claims 5, 7, 9, 16-18, 29, 34, and 41. Specifically the Examiner acknowledges that OraEDI and Smithies fail to teach carrying forward the generic sections from the selected transaction document into the generic document to protect one or more confidential details in the selected transaction document, as recited in the claims. (12 May 2005 Office Action, Pages 8-12). However, the Examiner asserts that the cited portions of Keller disclose the acknowledged shortcomings in OraEDI and Smithies. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in Keller.

As mentioned above, OraEDI or Smithies, either individually or in combination, fail to disclose, teach, or suggest: (1) an electronic commerce system for third party document reuse of transaction documents; (2) one or more document repositories

storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document and capable of being used to facilitate a transaction with one or more of the parties to the transaction document; (3) a global content directory including a plurality of classes having one or more associated pointers that identify one or more document repositories; and (4) an intelligence module operable to encrypt at least a portion of the selected information in the selected transaction document thereby making it inaccessible in the generic document, as recited in amended independent claims 30, 35, and 42. Thus, the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of OraEDI, Smithies, or Keller either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that it would have been obvious to one of ordinary skill in the art to combine all references because all references are devoted to electronic business transactions. (12 May 2005 Office Action, Page 10).

The Applicant respectfully submits that these purported advantages relied on by the Examiner to make such a combination are nowhere disclosed, taught, or suggested in OraEDI, Smithies, or Keller, or in knowledge generally available to those of ordinary skill in the art at the time of the invention, either individually or in combination. The Applicant respectfully requests the Examiner to point to the portions of OraEDI, Smithies, or Keller, or to knowledge generally available to those of ordinary skill in the art at the time of the invention which contains the teaching, suggestion, or motivation to combine these references for the purpose of further enhancing an electronic business system's functionality. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of OraEDI, Smithies, or

Keller, or in knowledge generally available to those of ordinary skill in the art at the time of the invention, either individually or in combination.

With respect to dependent claims 2-11, 13-19, 21-27, 29 31-34, and 36-41, claims 2-11 and 29 depend from amended independent claim 30, claims 13-19 and 31-34 depend from amended independent claim 35, and claims 21-27 and 36-41 depend from independent claim 42. As mentioned above, each of amended independent claims 28, 35, and 42 include limitations similar to those discussed above in connection with amended independent claim 30. Thus, amended independent claims 28, 35, and 42 are considered patentably distinguishable over OraEDI, Smithies, or Keller for at least the reasons discussed above in connection with amended independent claim 30. Thus, dependent claims 2-11, 13-19, 21-27, 29 31-34, and 36-41 are considered patentably distinguishable over the proposed combination of OraEDI, Smithies, or Keller for at least the reasons of depending from an allowable claim and are therefore considered to be in condition for allowance.

For at least the reasons set forth herein, the Applicant submits that claims 2-11, 13-19, and 21-42 are not rendered obvious by the proposed combination of OraEDI, Smithies, or Keller, or in knowledge generally available to those of ordinary skill in the art at the time of the invention. The Applicant further submits that claims 2-11, 13-19, and 21-42 are not rendered obvious by the proposed combination of OraEDI, Smithies, or Keller, or in knowledge generally available to those of ordinary skill in the art at the time of the invention, and are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 2-11, 13-19, and 21-42 under 35 U.S.C. § 103(a) be reconsidered and that claims 2-11, 13-19, and 21-42 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

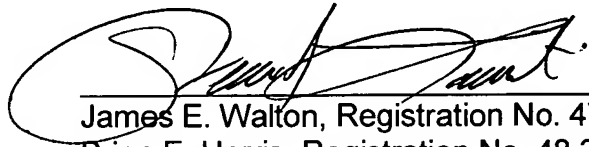
In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

7/25/05
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